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No. 217

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In the Supreme Court of the United States

LESTER W. BAILEY,
Petitioner,

v.

SEARS ROEBUCK & CO.,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE NINTH CIRCUIT AND BRIEF OF PETITIONER.

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In the Supreme Court of the United States

LESTER W. BAILEY,
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vs.

SEARS, ROEBUCK & COMPANY, a corporation,
Respondent.

No.....

PETITION FOR CERTIORARI

TO the Chief Justice and the Associate Justices of the Supreme Court of the United States:

The petitioner, Lester W. Bailey, by John F. Reilly, and MacCormac Snow, his attorneys, prays that a Writ of Certiorari issue to review the decree of the United States Circuit Court of Appeals for the Ninth Circuit affirming the Decree of the District Court of the United States for the District of Oregon which held invalid United States Patent 1,907,473 issued to Petitioner.

Summary Statement of Matter Involved

The Plaintiff-Petitioner charges infringement of United States Patent 1,907,473 issued to him May 9, 1933, on an application filed March 17, 1932, for a variable condenser indicating and operating mechanism, useful for tuning radio receiving sets to short wave signals. Defendant-Respondent denied validity and infringement, and relied on eight reference patents, not to anticipate the patent in suit, but to explain the prior art on the issue of invention. The sole issue on validity was that of invention. Defendant admitted in open court that none of the reference patents anticipated the patent in suit (160).

The issues under this petition involve no conflicting testimony.

The case was tried to a Master who held the patent invalid but infringed by a widely sold accused model and not infringed by two infrequently sold accused models. The District Court of Oregon held the patent invalid and did not pass on infringement. The Circuit Court of Appeals for the Ninth Circuit affirmed this Decree holding the patent invalid upon three of the reference patents, namely, French patent to Rysman, English patent to Hall, and United States patent to Huth.

The Rysman French patent cited by the Patent Office is the reference over which the Bailey patent issued, and is the most pertinent reference in this record. Huth is a secondary reference and Hall is

less pertinent than Rysman.

At the trial uncontradicted evidence was introduced tending to show (1) that the patent in suit differs distinctly in structure from the prior art; and (2) that there are inherent in the Bailey mechanism certain functions and results which are new. These new functions and results are not set forth in the patent in suit, except inferentially as inherent attributes of the structure claimed. The Court below held the patent invalid because the new functions and results are not set out in the patent.

Jurisdiction

This is a suit in equity in which the complaint (2) alleges infringement of a U. S. patent and asks for accounting and injunction. District Court jurisdiction is based on U.S.C.A. 28:41. Circuit Court of Appeals jurisdiction is based on U.S.C.A. 28:225 (a) and (d). The matters relied on in this application were before the District Court on objections to the Master's report (Objections 34 ps. 51-56; 46 pp. 69-73) and were specified as error in Petitioner's brief to the Circuit Court of Appeals.

This Court has jurisdiction to review the Decree of the Circuit Court of Appeals in this cause by certiorari under U.S.C.A. 28:347 and 350. This Decree was dated November 28, 1940. Petitioner filed a Petition for Re-hearing in the Circuit Court of Appeals which petition was denied February 4, 1941.

Upon a proper application to this Court filed by Petitioner April..., 1941, Mr. Justice Douglas on April 30, 1941, made an order extending time for the filing of this petition to and including June 30, 1941.

Questions Presented

1. Where new functions and results are not set forth in a patent but are inherent in the structure claimed in the patent shall they be considered as evidence of patentability?

2. Does the record in this case show that Respondent has sustained its burden of proof by showing that the claims of the patent in suit or either of them are invalid?

Reasons Relied On for Issuance of Writ

The basis of this application is that the Ninth Circuit has decided an important question of Federal law in a way probably in conflict with applicable decisions of the Supreme Court, or that this question has not been but should be decided by the Supreme Court.

The first question raised by the petition goes to the content of all patents and patent applications. It affects every applicant for a patent. There are filed nearly 100,000 applications per year. It affects every manufacturer, jobber, distributor, and retailer who may be called upon to determine the validity

and scope of a patent, and whether its prohibitions apply to him. It affects the Patent Office of which a ruling is required on each application. We can think of no more fundamentally important question in the field of patent law than: What recitals must be contained in a patent application and the resulting patent?

WHEREFORE Petitioner respectfully prays as at the beginning of this petition and that upon further consideration of this cause this Court may be pleased to reverse and remand the same to the Circuit Court of Appeals for the Ninth Circuit with direction to pass on questions of infringement.

JOHN F. REILLY,
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MACCORMAC SNOW,
Of Counsel for Petitioner.